

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Oxman et al.	Art Unit:	2162
Serial No.:	10/729,517	Examiner:	Giovanna B. Colan
Filed:	December 5, 2003		
Title:	PRODUCING DOMESTIC RELATIONS ORDERS		

Mail Stop Appeal Brief- Patents

Commissioner for Patents

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APPEAL BRIEF

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(i) REAL PARTY IN INTEREST

The real party in interest is FMR CORP., a corporation organized under the laws of Delaware.

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(ii) RELATED APPEALS AND INTERFERENCES

The appellant is not aware of any prior or pending appeals, judicial proceedings, or interferences related to the above-identified patent application.

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(iii) STATUS OF CLAIMS

Claims 1-3, 3-24, and 26-31 stand rejected in the application. Claim 4 and 25 stand withdrawn.

Claims 1-3, 3-24, 26, and 28-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Broadbent et al. U.S. Patent Application Publication 2001/0047326, in view of Fay et al. U.S. Patent Application Publication 2002/0188540, and further in view of Esposito U.S. Patent Application Publication 2001/0051906. Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Broadbent et al. U.S. Patent Application Publication 2001/0047326, in view of Fay et al. U.S. Patent Application Publication 2002/0188540, and in view of Esposito U.S. Patent Application Publication 2001/0051906, and further in view of Cohen et al. U.S. Patent Application Publication 2004/0064404.

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(iv) STATUS OF AMENDMENTS

None

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(v) SUMMARY OF CLAIMED SUBJECT MATTER

A. Claim 1

Claim 1 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 1 describes a computerized system for producing a domestic relations order. [See e.g. Appellant's FIG. 2; specification pg. 7, ¶ [0040] lines 1-3; FIG. 3, pg. 9, ¶ [0044] lines 1-2]. Another feature of claim 1 describes a receiver for receiving information, alternate payee and court information, relating to a domestic relations order. [See e.g. Appellant's specification pg. 3, ¶ [0009] lines 1-3 and 5-7]. Another feature of claim 1 describes a rules engine in communication with the receiver for selecting sample text passages. [See e.g. Appellant's FIG. 3; specification pg. 3, ¶ [0009] lines 3-4, ¶ [0010] lines 4-5, pg. 9, ¶ [0046] line 3, pg. 10, ¶ [0047], lines 1-14]. Another feature of claim 1 describes a document assembler for automatically incorporating a first subset of the sample text passages and a second subset of the received information comprising the alternate payee and the court information into a court-compliant domestic relations order for submission to a court. [See e.g. Appellant's FIG 3; specification, pg. 9, Para. [0046] line 2, pg. 10-11, ¶ [0048] lines 1-10, pg. 12, ¶ [0050], lines 14-15].

C. Claim 3

Claim 3 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 3 describes information associated with a legal representative of the participant. [See e.g. Appellant's FIG. 14; specification pg. 3, ¶ [0009] lines 5-7, pg. 4, ¶ [0012] lines 3-4, pg. 14, ¶ [0058] lines 1-2]

B. Claim 5

Claim 5 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 5 describes information associated with a legal representative of the alternate payee. [See e.g. Appellant's FIG. 14; specification pg. 3, ¶ [0009] lines 5-7, pg. 4, ¶ [0012] lines 3-4, pg. 14, ¶ [0058] lines 1-2]

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C. Claim 6

Claim 6 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 6 describes a data storage device for storing rules relating to a domestic relations order. [See e.g. Appellant's FIG. 3; specification pg. 11, ¶ [0049] lines 4-6]

D. Claim 8

Claim 8 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 8 describes sample text passages related to a domestic relations order. [See e.g. Appellant's FIG. 3; specification pg. 3, ¶ [0010] lines 2-4, ¶ [0011] lines 2-4, pg. 11, ¶ [0048] lines 3-4].

E. Claim 9

Claim 9 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 9 describes a rules engine which selects the first subset of sample text passages based, in least in part, on the stored rules. [See e.g. Appellant's FIG. 3; specification pg. 3, ¶ [0010] lines 4-5, pg. 9, ¶ [0046] lines 3]. [can't find based on stored rules explicitly]

F. Claim 10

Claim 10 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 10 describes a rules engine which selects the first subset of sample text passages based, in least in part, on the received information. [See e.g. Appellant's FIG. 3; specification pg. 2, ¶ [0010] lines 4-5, pg. 9, ¶ [0046] lines 3, ¶ [0011] lines 2-4].

G. Claim 11

Claim 11 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 11 describes the document assembler receiving additional information previously included in a domestic relations order from the data storage device. [See e.g. Appellant's FIG. 18; specification pg. 3, ¶

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[0010] lines 4-5, pg. 4, ¶ [0012] lines 1-2, pg. 12, ¶ [0050] lines 13-14, pg. 15, ¶ [0062] lines 9-12].

H. Claim 13

Claim 13 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 13 describes a method for producing a domestic relations order. [See e.g. Appellant's FIG. 1; specification pg. 5, ¶ [0035] through ¶ [0039], pgs. 6-7]. Another feature of claim 13 describes a method for providing a plurality of sample text passages relating to domestic relations orders, the sample text passages including embedded parameters comprising an alternate payee and court information. [See e.g. Appellant's FIG. 3; specification pg. 3, ¶ [0010] lines 2-4, ¶ [0011] lines 2-4, pg. 11, ¶ [0048] lines 3-4]. Another feature of claim 13 includes requesting and receiving information for inclusion into a domestic relations order where the requested information including values for one or more of the embedded parameters. [See e.g. Appellant's FIG. 3; specification pg. 3, ¶ [0009] lines 2-3, ¶ [0011] lines 4-5 and 9-11, pg. 4, ¶ [0012] line 1, ¶ [0014] line 4, pg. 9, ¶ [0045] lines 9-11, ¶ [0046] lines 4-6]. Another feature of claim 13 includes automatically assembling a court-compliant domestic relations order for submission to a court using a first subset of the sample text passages and a second subset of the requested information. [See e.g. Appellant's FIG. 3 and FIG. 5; specification pg. 2, ¶ [0005], lines 8-9, pg. 3, ¶ [0010] lines 2-5, ¶ [0011], lines 2-3, ¶ [0013] line 3, ¶ [0014], pg. 11, ¶ [0048], line 3, pg. 12, ¶ [0050] lines 14-15, ¶ [0051] lines 14-15].

I. Claim 17

Claim 17 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 17 describes receiving a subset of the requested information form a preciously completed domestic relations order. [See e.g., Appellant's FIG. 18; specification pg. 3, ¶ [0010] lines 4-5, pg. 4, ¶ [0012] lines 1-2, pg. 12, ¶ [0050] lines 13-14, pg. 15, ¶ [0062] lines 9-12].

J. Claim 20

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Claim 20 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 20 describes receiving a subset of the requested information associated with a legal representative of a participant in an employee benefit plan. [See e.g., Appellant's FIG. 14; specification pg. 3, ¶ [0009] lines 5-7, pg. 4, ¶ [0012] lines 3-4, pg. 14, ¶ [0058] lines 1-2].

K. Claim 22

Claim 22 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 22 describes receiving a subset of the requested information associated with a legal representative of a participant in an employee benefit plan. [See e.g., Appellant's FIG. 14; specification pg. 3, ¶ [0009] lines 5-7, pg. 4, ¶ [0012] lines 3-4, pg. 14, ¶ [0058] lines 1-2].

L. Claim 23

Claim 23 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 23 describes a set of rules related to generating a domestic relations order [See e.g., Appellant's FIG. 3; specification pg. 3, ¶ [0010] lines 1-2, pg. 9, ¶ [0046] line 3].

M. Claim 24

Claim 24 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 24 describes automatically assembling a court-compliant domestic relations order as comprising the subset of the sample text passages based, at least in part, on the rules. [See e.g., Appellant's FIG. 3; specification pg. 3, ¶ [0010] lines 2-4, ¶ [0011] lines 2-4, pg. 11, ¶ [0048] lines 3-4].

N. Claim 26

Claim 26 is described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 26 describes a computerized system for producing a domestic relations order. [See e.g., Appellant's FIG. 2; specification pg. 7, ¶ [0040] lines 1-3; FIG. 3, pg. 9, ¶ [0044] lines 1-2]. Another feature

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of claim 26 is means for storing sample text passages for inclusion into a domestic relations order, the sample text passages including embedded parameters comprising an alternate payee and court information. [See e.g., Appellant's FIG. 3, 355, 360 and 370]. Another feature of claim 26 is means for receiving information about a first domestic relations order, the information providing values for one or more of the embedded parameters; [See e.g., Appellant's FIG. 3, 310, pg. 9, ¶ [0045] lines 7-9]. Another feature of claim 26 is means for automatically assembling a court-compliant domestic relations order for submission to a court using a first subset of the stored sample text passages and at least a second subset of the received information. [See e.g., Appellant's FIG. 3, 330, pg. 9, ¶ [0046] lines 1-4]

O. Claim 31

Claim 31 described at least in the specification and figures at the cited locations which describe exemplary aspects of the claim. Claim 31 describes the court-compliant DRO is assembled according to one or more predefined document formats. [See e.g., Appellant's specification pg. 11, ¶ [0048] lines 3-4].

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-3, 5-24, 26 and 28-31 are unpatentable under 35 U.S.C. §103(a) over Broadbent et al U.S. Patent Application Publication 2001/0047326, in view of Fay et al. U.S. Patent Application Publication 2002/0188540, and further in view of Esposito U.S. Patent Application Publication 2001/0051906. The claims do not stand or fall together.

- a. Group I includes claims 1, 2, 7, 12-16, 18, 19, 21, 26, 28, 29.
- b. Group II includes claims 3, 5, 20, 22.
- c. Group III includes claims 6, 8, 9, 10, 11, 17, 23, 24 and 31.

B. Whether claim 27 stands rejected under 35 § U.S.C. §103(a) as being unpatentable over Broadbent et al U.S. Patent Application Publication 2001/0047326, in

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view of Fay et al. U.S. Patent Application Publication 2002/0188540, and in view of Esposito U.S. Patent Application Publication 2001/0051906, and further in view of Cohen et al. U.S. Patent Application Publication 2004/0064404.

a. Group I includes claim 27.

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(vii) ARGUMENT

(i) Rejection under 35 U.S.C. § 103(a) over Broadbent et al. US Patent App. Pub. 2001/0047326 A1, in view of Fay et al. US Patent App. Pub. 2002/0188540 A1, and further in view of Esposito US Patent App. Pub. 2001/0051906

a. Group I – 1, 13, 26 (dependant claims 2, 7, 12, 14, 15, 16, 18, 19, 21, 27, 28, 29)

The combination of Broadbent, Fay and/or Esposito does not teach producing a Domestic Relation Order as claimed

Claims 1, 13, and 26 each require receiving particular input information related to producing Domestic Relations Orders (DROs), specifically, alternate payee and court information, and producing a court compliant output of a Domestic Relations Order (DRO) using that input information. Broadbent and Esposito are completely silent with respect to DROs and Fay does not show using particular inputs to produce a DRO. The combination does not suggest the claimed invention nor provide any indication how Broadbent could be modified to arrive at the claimed invention. The Examiner is impermissibly relying on the hindsight of the Appellants' disclosure to provide all of the missing details.

As the Examiner has stated "Broadbent does not expressly disclose a domestic relations order." (02/12/2007 Office Action at pg. 3) The Examiner does go on to state that Broadbent does disclose "a receiver for receiving information (Figure 4A, item 401, pg. 9, ¶ [0123], lines 3-8, Broadbent)" (*Id.* at pg. 3). In Broadbent, Figure 4A, item 401 shows the input of a borrower, property and originator date via loan origination gateway and pg. 9, ¶ [0123], lines 3-8, shows "Original inputs from a lender/loan originator come into the system 401 through the 'Loan Originator Gateway' (451 in FIG. 4c) or portal, which serves as an 'entry point' or gateway to the 'pipeline' or system for loan originator data and borrower data." This clearly is not "a receiver for receiving information relating to a domestic relations order, said information comprising an alternate payee and court

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information" because this specific information is not included. Broadbent inputs are not even analogous to the inputs for producing a DRO because the required input of a loan originator and borrower focus on information about the lender and borrower to determine if a loan complies with the loan rules, not the destination of an output document that will be generated or its third party beneficiary.

Further, even if, for the sake of this argument only, this were analogous, the combination of Fay does not result in the claimed invention. The Examiner states that "Fay discloses a receiver for receiving information relating to a domestic relations order. (pg. 2 and 8, ¶ [0015] and [0077], lines 1-6 and 1-8;" (See e.g., *Id.* at pg. 3) This provides no direction as to modifications of Broadbent to arrive at the Appellants' claimed invention. Fay shows an annuity calculation system having a variable immediate annuity ("VIA") module 34 which may be affected by the receipt of an issued Qualified Domestic Relations Orders (QDROs). (See. e.g., Fay at ¶ [0077], lines 1-10). Fay, however is silent on the type of information that is received, the type of information needed to generate a QDRO and automated processing of that information to generate a QDRO. Fay does not express producing a DRO. The Examiner states that Fay expresses the "need to provide a defined retirement benefit which will guarantee an individual a minimum defined income level upon the individual's retirement" (See e.g., *Id.* at ¶ [0012], lines 1-3), and that Fay satisfies that need by "providing a user with a plurality of periodic retirement income payments" (See e.g., *Id.* at ¶ [0014], lines 3-5). These cites, however, do not teach or even suggest that producing a DRO is a need or a part of what is required to determine periodic retirement income payments. Broadbent also does not produce a DRO, instead a required set of tasks for a specific loan is produced (See e.g., Broadbent at ¶ [0125], lines 5-9). Combining the Broadbent features of loan originator and borrower input and the Fay feature of receiving a DRO to properly calculate annuities does not result in "a receiver for receiving information relating to a domestic relations order, said information comprising an alternate payee and court information." Neither reference discloses alternate payee and court information. Moreover, even if

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alternate payee and court information were disclosed by Fay, there is nothing in Fay to suggest that such inputs would be the needed inputs to be used by an automated system to generate a court compliant DRO.

Moreover, Esposito does not provide what both Broadbent and Fay fail to suggest. Esposito makes no explicit mention of DROs. Further, Esposito, as the Examiner cites it, teaches away from the claimed invention. Specifically, the Examiner cites that Esposito teaches "the invention is a system that complies with reporting and disclosure requirements for employee benefit plans, e.g., ERISA, IRS, other federal law and state reporting and disclosure requirements and electronic communications regulations, as they relate to employee benefit plans" (See e.g., Esposito at ¶ [0008], lines 8-13). The examiner has ignored that Esposito's system complies with the rules by notifying the recipient via e-mail of the required plan communication. (See e.g., *Id.* at ¶ [0045], lines 1-6). This teaches away from the claimed invention because the DROs can be printed and submitted to the proper court, not submitted to a plan participant via e-mail as is done in Esposito. (See e.g., Appellant's Specification at ¶ [0038])

In conclusion, Broadbent, Fay and Esposito, individually or in combination, do not teach modification to produce a DRO in the claimed manner apart from considering the Appellants' invention.

The combination of Broadbent, Fay and/or Esposito does not teach court-compliance

Claims 1, 13 and 26 of the present invention each require an output of a court-compliant DRO. Although Broadbent suggests compliance with Federal, State, local and professional regulations and Esposito suggests compliance with Federal and State rules, Broadbent, Fay and Esposito are completely silent with respect to court-compliance. The combination does not suggest the claimed invention, taken as a whole, nor provide an indication how Broadbent could be modified to arrive at the claimed invention. The

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Examiner is impermissibly relying on the hindsight of the Appellants' disclosure to make the leap from the broad statements cited to the Appellants' claimed invention.

Broadbent does not show generating a document that is court-compliant. The Examiner has cited Figure 18, "loan programs that fit the criteria you entered on the previous pages" and page 10, ¶ [0125], lines 5-9 in Broadbent (02/12/2007 Office Action at pg. 5). In Broadbent, "loan programs that fit the criteria you entered on the previous pg.s" in Figure 18 refers to "such data or information is required for originating and underwriting a loan, and typically includes the following: a subscribing loan originator's identification FIG. 7, pertinent information sufficient to identify the pending borrower FIG. 13, and information on the subject property FIG. 14," (See e.g., Broadbent at ¶ [0132], lines 1-6). Further, ¶ [0125], lines 5-9 shows loan data "passed by the system to the Compliance Engine 479 and the Compliance Engine uses these data (the loan data 477 and the user task selections 479) to generate a required set of tasks for this specific loan." This is clearly not "the court information into a court-compliant domestic relations order for submission to a court" nor even analogous to "the court information into a court-compliant domestic relations order for submission to a court." Broadbent's Compliance Engine ensures compliance with Federal, State, local and professional regulations by generating a complying set of tasks for creating a mortgage (See e.g., *Id.* at ¶ [0125], lines 5-9 and ¶ [0026], lines 1-4). That compliance does not extend to or fall within complying with court rules that govern the format for generating a DRO to be reviewed by the court. While both the Broadbent description and the Appellants' claimed inventions comply with rules, compliance with rules is a broad idea which is present in almost all computer systems, and does not teach or suggest how to generate a DRO for court-compliance.

Further, even if, for the sake of this argument only, the generation of tasks to ensure compliance were analogous, the combination of Fay does not result in the claimed invention. Though the Examiner cites Fay pg. 2 and 8, paragraphs [0015] and [0077], lines 1-6 and 1-8 (02/12/2007 Office Action at pg. 5), Fay is completely silent with

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respect to generating a court-compliant document. In fact, nowhere in the description cited by the Examiner is there even any teaching on complying with rules. Paragraph 15, lines 1-6 discuss a retirement quoting process and paragraph 77, lines 1-8 discuss an annuity calculation system having a variable immediate annuity ("VIA") module 34 which may be affected by the receipt of an issued Qualified Domestic Relations Orders (QDROs). As argued above, Broadbent also does not show court compliance, but instead complying with the Federal, State, local and professional mortgage loan regulations (See e.g., Broadbent at ¶ [0012], lines 5-11 and ¶ [0026], lines 1-4). Combining the Broadbent features of Federal, State, local and professional mortgage loan regulations compliance with a retirement quoting process and/or a variable immediate annuity calculation affected by the receipt of a DRO does not result in "the court information into a court-compliant domestic relations order for submission to a court." (Appellant's Claim 1) Neither reference discloses generating a DRO for court-compliance. Moreover, even if court-compliance were disclosed by Fay, there is nothing in Fay to suggest such compliance would be the needed compliance to be used by an automated system to generate a court-compliant DRO.

Moreover, Esposito does not provide what both Broadbent and Fay fail to suggest. The Examiner has pointed out that on pg. 1, paragraph [0008], lines 8-13 in Esposito (02/12/2007 Office Action at pg. 5), Esposito teaches compliance with federal and state rules to avoiding "potential penalties assessed by a federal court or government agency for non-compliance". This cited description, however, is not the same as court-compliance needed to generate a DRO. Even though penalties may be issued by a federal court, it is not court regulations for DRO generation that is complied with in Esposito but federal laws, state reporting disclosure requirements and electronic communications regulations, as they relate to employee benefit plans.

In conclusion, Broadbent, Fay and Esposito, individually or in combination, do not teach modification to produce a DRO in the claimed manner apart from considering Appellants' invention.

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The combination of Broadbent, Fay and/or Esposito does not teach the use of court information

Claims 1, 13 and 26 of the present invention each require court information. Although Esposito mentions the potential for penalties assessed by a federal court for non-compliance Federal and State rules, Broadbent, Fay and Esposito are completely silent with respect to court-compliance. The combination does not suggest the claimed invention, taken as a whole, nor provide an indication of how Broadbent could be modified to arrive at the claimed invention. The Examiner is impermissibly relying on the hindsight of the Appellants' disclosure to make the leap from the broad statements cited to the Appellants' claimed invention.

As the Examiner has stated "Broadbent in view of Fay is silent with respect to court information." (02/12/2007 Office Action at pg. 4) The Examiner does go on to state that "Esposito does disclose a system similar to the combination of Broadbent in view of Fay's including: court information (pg. 1, ¶ [0008], lines 5-7 and 21-29; Esposito)." *Id.* Although the cite mentions a federal court, mere mention of a court does not indicate the use of that court's information. Esposito shows compliance with reporting and disclosure requirements for employee benefit plans to avoid potential penalties assessed by a federal court and does not show court information. Moreover, even if court information were disclosed by Esposito, there is nothing in Esposito to suggest such court-information would be the needed information to be used by an automated system to generate a court-compliant DRO.

Cohen does not provide what Esposito fails to suggest. The Examiner Cohen as a basis of rejection for claim 27. The examiner cites pg. 4, paragraph [0042], lines 4-8 in Cohen as disclosing bankruptcy case-specific data (02/12/2007 Office Action at pg. 15 to pg. 16). Cohen shows the court, judge, attorney, trustee, issuer, account and a case number related to a bankruptcy filing. As is shown in a preferred embodiment of the

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Appellant's Specification, paragraph [0060], the court that will issue the DRO is used to assure that the DRO produced is properly formatted and is not analogous to a field in a database holding court information extracted from a bankruptcy notice to be used for checking if a credit appellant has filed for bankruptcy. Additionally, there is no showing in Cohen regarding how to use bankruptcy case-specific data to produce a DRO and there is nothing to suggest that bankruptcy case-specific data is even the same data needed to produce a DRO. Further, there is nothing in Cohen to suggest modification to use the bankruptcy notice information to produce a DRO.

In conclusion, Broadbent, Fay and Esposito, individually or in combination, do not teach modification to produce a DRO in the claimed manner apart from considering Appellants' invention.

The combination of Broadbent, Fay and/or Esposito does not teach document preparation for submission to a court

Claims 1, 13 and 26 of the present invention each require document generation for submission of that document to a court. Although Broadbent and Esposito suggest providing documents, Broadbent, Fay and Esposito are completely silent with respect to preparing a document for court submission. The combination does not suggest the claimed invention, taken as a whole, nor provide an indication how Broadbent could be modified to arrive at the claimed invention. The Examiner is impermissibly relying on the hindsight of the Appellants' disclosure to make the leap from the broad statements cited to the Appellants' claimed invention.

Broadbent does not show document submission to a court. Though the examiner cites to paragraph [0125], lines 5-9, in Broadbent, Broadbent is completely silent with respect to submitting a document to a court. Again, nowhere in the description cited by the Examiner is there even any teaching on producing a document in preparation for

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submission to a court. Paragraph [0125], lines 5-9, discuss a compliance engine that ensures compliance with Federal, State, local and professional regulations by generating a complying set of tasks for creating a mortgage. However, Broadbent does show documents provided by the loan originator to the mortgage appellant (See e.g., Broadbent at ¶ [0092], lines 1-5), documents provided by the mortgage appellant to the loan originator (See e.g., *Id.* at ¶ [0101], lines 12-14), mortgage documents provided by the system to the loan originator, premium broker processor and to the premium broker processor account executive (See e.g., *Id.* at ¶ [0275], lines 16-21), and the system documenting "all attendant processes with compliance to applicable regulatory rule sets and requirements of participating workers." (See e.g., *Id.* at ¶ [0118], lines 10-14). Not one of these documents is produced for submission to a court. Additionally, there is nothing in Broadbent to suggest modification for submitting these documents to a court. While both Broadbent and the Appellant's claimed invention disclose providing a document, providing a document is a broad idea that does not suggest providing a document for submission to a court.

Further, even if, for the sake of argument producing documents for delivery to the parties of a mortgage were analogous to producing a document for court submission the combination of Fay does not result in the claimed invention. Though the Examiner cites Fay pg. 2 and 8, paragraphs [0015] and [0077], lines 1-6 and 1-8 (02/12/2007 Office Action at pg. 5), Fay is completely silent with respect to court submission. In fact, nowhere in the description cited by the Examiner is there even any teaching on court submission. As stated above, paragraph 15, lines 1-6 discuss a retirement quoting process and paragraph 77, lines 1-8 discuss an annuity calculation system having a variable immediate annuity ("VIA") module 34 which may be affected by the receipt of an issued Qualified Domestic Relations Orders (QDROs). Broadbent also does not show court submission, but instead delivering documents to the parties of a mortgage. Combining the Broadbent features delivering documents to the parties of a mortgage with a retirement quoting process and/or a variable immediate annuity calculation affected by

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the receipt of a DRO does not result in “the court information into a court-compliant domestic relations order for submission to a court.” (Appellant’s Claim 1) Neither reference discloses generating a DRO for court submission. Moreover, even if court submission were disclosed by Fay, there is nothing in Fay to suggest such court submission would be the needed court submission to use an automated system to generate a court-compliant DRO.

Moreover, Esposito does not provide what both Broadbent and Fay fail to suggest. The Examiner has pointed out that on pg. 1, paragraph [0008], lines 8-13 in Esposito (02/12/2007 Office Action at pg. 5), Esposito teaches compliance with federal and state rules to avoiding “potential penalties assessed by a federal court or government agency for non-compliance”. This cited description, again, does not describe submission to a court. Although penalties may be issued by a federal court, it does not follow that submission of an automatically produced DRO to a court is to occur. Esposito does show an e-mail message including a link to location a document can be viewed by one of the recipients (plan participant(s)) on the recipient list (See e.g., Esposito at ¶ [0045], lines 1-5 and ¶ [0045], lines 1-6). Submission of an e-mail to an employee benefit plan participant is not the same as submission of a DRO to a court.

In conclusion, Broadbent, Fay and Esposito, individually or in combination, do not teach modification to produce a DRO in the claimed manner apart from considering Appellants’ invention.

b. Group II – 3, 5, 20, 22

Broadbent, Fay and/or Esposito do not teach using legal representative information

Claims 3, 5, 20, 22 of the present invention each require use of legal representative information. Although Broadbent shows advisors and accountants, Broadbent, Fay and Esposito are completely silent with respect to legal representative information. The combination does not suggest the claimed invention, taken as a whole,

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nor provide and indication how Broadbent could be modified to arrive at the claimed invention. The Examiner is impermissibly relying on the hindsight of the Appellants' disclosure to make the leap from the broad statements cited to the Appellants' claimed invention.

Broadbent does not show a legal representative. The examiner cites to Paragraph 0097, lines 1-7, in Broadbent, (02/12/2007 Office Action at pg. 6, pg. 20 and pg. 12) which shows non-legal representatives, "investment advisors, financial advisors, accountants and other professionals may be added to the Program as Loan Originators." (See e.g., Broadbent at ¶ [0097], lines 1-7). In the preferred embodiment, FIG. 12 shows a legal representative as an attorney. Advisors, accountants and loan originators are not legal representatives. While both Broadbent and the Appellant's claimed invention disclose providing representatives, providing a representative is a broad idea that does not suggest providing a legal representative qualified to represent parties of a DRO.

In conclusion, Broadbent, Fay and Esposito, individually or in combination, do not teach modification to produce a DRO in the claimed manner apart from considering Appellants' invention.

c. Group III – 6, 8, 9, 10, 11, 17, 23, 24 and 31

Broadbent, Fay and/or Esposito do not teach rules or information related to DROs

Claims 6, 8, 9, 10, 11, 17, 23, 24 and 31 of the present invention all require rules or information related to DROs. Although Broadbent shows rules and information related to a mortgage and Esposito shows rules and information related to employee benefit plans, Broadbent, Fay and Esposito are completely silent with respect to rules or information related to DROs. The combination does not suggest the claimed invention, taken as a whole, nor provide and indication how Broadbent could be modified to arrive at the claimed invention. The Examiner is impermissibly relying on the hindsight of the

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Appellants' disclosure to make the leap from the broad statements cited to the Appellants' claimed invention.

Broadbent does not show rules or information related to DROs. Broadbent has a Compliance Engine which uses a rule-based loan compliance database to generate tasks required to be performed to complete a mortgage (See e.g., Broadbent at ¶ [0051], lines 1-6). The rules and information required to complete a mortgage (e.g., Real Estate Settlement Procedures Act, total cost of the loan (*Id.* at ¶ [0013], lines 1-13)) are not the same rules or information required for a DRO (e.g., format for court submission (Appellant's Specification at ¶ [0039]), or court information (*Id.* at ¶ [0005])). Additionally, there is nothing in Broadbent to suggest modifying the Compliance Engine or information to relate to DROs. While both Broadbent and the Appellant's invention shows the use of rules and information, the use of rules and information is a broad idea which most all computers systems use and does not show the rules or information related to a DRO.

Further, even if, for the sake of this argument only, the rules and information related to mortgages were analogous, the combination of Fay does not result in the claimed invention. Even though Fay shows a QDRO Fay does not use the rules or information related to producing a DRO, Fay simply uses the court issued QDRO as a variable in an annuity calculation. Combining the Broadbent features of rules and information related to mortgages and the Fay feature of receiving a QDRO to properly calculate annuities does not result in rules or information related to DROs. Neither reference discloses rules for the formatting of a DRO or alternate payee and court information. Moreover, even if rules for the formatting of a DRO, alternate payee and court information were disclosed by Fay, there is nothing in Fay to suggest that such rules and information would be the rules and information needed for an automated system to generate a court compliant DRO.

Moreover, Esposito does not provide what both Broadbent and Fay fail to suggest. Esposito makes no explicit mention of rules or information related to DROs. The

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Examiner cites Esposito paragraph 0068, lines 14-25. The cite is completely silent with respect to rules, though it shows the information of a user name, ID number, personal identification number, password, plan, state of user session, etc. This information is not the same information required, alternate payee and court information, to generate a court compliant DRO. Even though information is used, it is not the information required for a DRO.

In conclusion, Broadbent, Fay and Esposito, individually or in combination, do not teach modification to produce a DRO in the claimed manner apart from considering Appellants' invention.

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SUMMARY CONCLUSION OF ALL ARGUMENTS

The Examiner has not met the initial burden of establishing a *prima facie* case for obviousness. As described in the MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As argued herein, there is no motivation and further, the combinations made by the Examiner do not teach or suggest all the claim limitations. The invention must be considered as a whole and the Examiner cannot simply chose references using the claim elements as a guide.

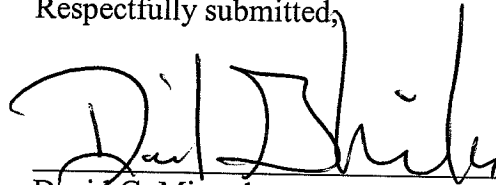
Further, as stated many times, the Examiner has simply ignored claim limitations, abstracting some claim limitations to a general concept to enable the Examiner's obviousness rejections. It is clear, however, that the type of data and/or the use of specific data can be patentable and must be considered. For example, just because automating processes is known, this does not mean that automating the production of a court-compliant DRO for court submission is obvious. Similarly, DRO's are received by many agencies, for many purposes, e.g. used as a variable in an annuity calculation as in Fay. However, this does not mean that *any* mention of a DRO makes it obvious to produce a court-compliant DRO. While Broadbent does show producing documents, producing documents is an ancillary function of Broadbent which is used to show ensure compliance required tasks for executing a mortgage and does not contemplate the system claimed by the Appellant. While the Examiner keeps arguing the inherent capability of the Broadbent system to be capable of automatically producing a DRO as claimed by the Appellant and to be capable of performing the functions as claimed by the appellant,

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there is no question that the Broadbent system would need to be reconfigured to do so. Besides the Appellant's own specification, there is *very little, if any* guidance on the record on how that would be done. The Examiner seems to be relying mostly on the knowledge of one skilled in the art. However, there is nothing indicating that one skilled in the art would have the knowledge, without reading the Appellant's specification, to make the modifications necessary to produce a court-compliant DRO for court submission.

In view of the foregoing authorities, remarks, and the inability of the references, alone or in combination, to anticipate, teach, or suggest the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the Examiner rejecting claims 1-3, 3-24, and 26-31 should be reversed.

Respectfully submitted,



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(viii) CLAIMS APPENDIX

1. (Currently amended) A computerized system for producing a domestic relations order comprising:

a receiver for receiving information relating to a domestic relations order, said information comprising an alternate payee and court information;

a rules engine in communication with the receiver for ~~authenticating the received information~~ selecting sample text passages; and

a document assembler for automatically incorporating a first subset of the sample text passages and a second subset of the received information comprising the alternate payee and the court information ~~the authenticated information into an assembled~~ a court-compliant domestic relations order for submission to a court.

2. (Currently amended) The system of a claim 1 wherein ~~a subset of the received information is received from~~ comprises information associated with a participant in an employee benefit plan.

3. (Currently amended) The system of a claim 2 wherein, ~~in addition to the subset of the received information received from the participant, additional data is received from~~ comprises information associated with a legal representative of the participant.

4. (Canceled)

5. (Currently amended) The system of claim ~~[[4]]~~ 3 wherein, ~~in addition to the subject of the received information received from the participant, the legal representative of the participant, and the alternate payee of the employee benefit plan, additional information is further received from~~ comprises information associated with a legal representative of the alternate payee of the ~~employee benefit plan.~~

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6. (Original) The system of claim 1 further including a data storage device for storing rules relating to a domestic relations order.
7. (Original) The system of claim 6 wherein the data storage device further stores sample text passages.
8. (Original) The system of claim 7 wherein the sample text passages relate to a domestic relations order.
9. (Currently amended) The system of claim ~~[[7]]~~ 6 wherein the rules engine further selects a the first subset of the sample text passages based, at least in part, on the stored rules.
10. (Currently amended) The system of claim ~~[[7]]~~ 1 wherein the rules engine further selects a the first subset of the sample passages based, at least in part, on the received information.
11. (Currently amended) The system of claim 6 wherein the document assembler receives at ~~least a subset of the~~ additional information from the data storage device, the ~~subset of received~~ additional information having been previously included in a domestic relations order.
12. (Original) The system of claim 1 further comprising an administrative module for maintaining the rules engine.
13. (Currently amended) A computerized method for producing a domestic relations order, comprising:
 - providing a plurality of sample text passages relating to domestic relations orders, the sample text passages including embedded parameters comprising an alternate payee and court information;

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requesting information for inclusion into a domestic relations order, the requested information including values for one or more of the embedded parameters;

receiving the requested information; and

automatically assembling ~~the~~ a court-compliant domestic relations order for submission to a court using a first subset of the sample text passages and ~~at least a second~~ subset of the ~~received~~ requested information.

14. (Currently amended) The method of claim 13 further comprising receiving the requested information over an electronic communications network.

15. (Currently amended) The method of claim 14 wherein the electronic communications network is one of a local area network, a wide area network, a telephone network, an intranet, ~~or the Internet,~~ or any combination thereof.

16. (Currently amended) The method of claim ~~[[14]]~~ 13 further comprising receiving the requested information through an online questionnaire.

17. (Currently amended) The method of claim 13 further comprising receiving at least a subset of the requested information from a previously completed domestic relations order.

18. (Currently amended) The method of claim 13 further comprising receiving at least a subset of the requested information ~~from~~ associated with a participant in an employee benefit plan.

19. (Currently amended) The method of claim 18 wherein the employee benefit~~[[s]]~~ plan comprises ~~is one of a defined contribution plan, and a defined benefit plan,~~ or both.

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20. (Currently amended) The method of claim 13 further comprising receiving ~~at least a~~ subset of the requested information ~~from~~ associated with a legal representative of a participant in an employee benefit plan.

21. (Currently amended) The method of claim 13 further comprising receiving ~~at least a~~ subset of the requested information from an alternate payee of an employee benefit plan.

22. (Currently amended) The method of claim 21 further comprising receiving at least a subset of the requested information ~~from~~ associated with a legal representative of the alternate payee of an employee benefit plan.

23. (Currently amended) The method of claim 22 further comprising providing a set of rules relating to ~~the composition of~~ generating a domestic relations order.

24. (Currently amended) The method of claim 23 wherein ~~the assembly step automatically assembling the court-compliant domestic relations order~~ further comprises determining the subset of the sample text passages based, at least in part, on the rules.

25. (Canceled)

26. (Currently amended) A computerized system for producing a domestic relations order, comprising:

means for storing sample text passages for inclusion into a domestic relations order, the sample text passages including embedded parameters comprising an alternate payee, and court information;

means for receiving information about a first domestic relations order, the information providing values for one or more of the embedded parameters; and

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means for automatically assembling a court-compliant domestic relations order for submission to a court using from a first subset of the stored sample text passages and at least a second subset of the received information and a subset of the stored sample text.

27. (New) The system of claim 1 wherein said court information comprises a case number.
28. (New) The method of claim 16 further comprising determining one or more questions for the online questionnaire based on a rules engine and a subset of the requested information.
29. (New) The method of claim 13 wherein assembling comprises using a document template.
30. (New) The method of claim 29 wherein automatically assembling the court-compliant domestic relations order comprises using a subset of the requested information as input for one or more parameter fields of the document template.
31. (New) The system of claim 1 wherein the court-compliant domestic relations order is assembled according to one or more predefined document formats.

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(ix) EVIDENCE APPENDIX

Broadbent et al U.S. Patent Application Publication 2001/0047326, in view of Fay et al. U.S. Patent Application Publication 2002/0188540, and view of Esposito U.S. Patent Application Publication 2001/0051906, and further in view of Cohen et al. U.S. Patent Application Publication 2004/0064404.

A. Broadbent et al U.S. Patent Application Publication 2001/0047326

Citation entered in the record by examiner in Notice of References Cited contained in July 6, 2006 Office Action and the February 12, 2007 Final Rejection.

B. Fay et al. U.S. Patent Application Publication 2002/0188540

Citation entered in the record by examiner in Notice of References Cited contained in July 6, 2006 Office Action and the February 12, 2007 Final Rejection. .

C. Esposito U.S. Patent Application Publication 2001/0051906

Citation entered in the record by examiner in Notice of References Cited contained in the February 12, 2007 Final Rejection.

D. Cohen et al. U.S. Patent Application Publication 2004/0064404

Citation entered in the record by examiner in Notice of References Cited contained in the February 12, 2007 Final Rejection.

E. Final Rejection

Final rejection entered by the examiner February 12, 2007.

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(x) RELATED PROCEEDINGS APPENDIX

None